IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.   09/855,109

FILED: May 14, 2001   Examiner: R. Pitaro

CASE NO.   RSW920000147US1   Group Art Unit: 2174

TITLE: METHOD, SYSTEM, AND COMPUTER-PROGRAM PRODUCT
                    FOR THE CUSTOMIZATION OF DROP-DOWN LIST BOXES
                    USING "HOT LISTS"

FILED ELECTRONICALLY ON October 10, 2006

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

<u>**APPELLANTS' BRIEF**</u>

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on

August 7, 2006. The Commissioner is authorized to charge the fee for filing of this

Appeal Brief to Deposit Account No. 09-0461.

1.   REAL PARTY IN INTEREST

The present application is assigned to International Business Machines

Corporation, having its principal place of business at New Orchard Road, Armonk, New

York 10504. Accordingly, International Business Machines Corporation is the real party

in interest.

2.   RELATED APPEALS AND INTERFERENCES

The Appellants, assignee, and the legal representatives of both are unaware of

any other appeal or interference which will directly affect or be directly affected by or

have a bearing on the Board's decision in this appeal.

3.   STATUS OF CLAIMS

A.   Claims canceled: None

B.   Claims withdrawn from consideration but not canceled: None

C.   Claims pending: 1, 3-11, and 13

D.   Claims allowed: none

E.   Claims rejected: 1, 3-11, and 13

F.   Claims appealed: 1, 3-11, and 13

Appealed claims 1, 3-11, and 13 as currently pending are attached as the Claims

Appendix hereto.

4.   **STATUS OF AMENDMENTS**

A Reply under 37 C.F.R. §1.112 was filed on February 1, 2006; no claim amendments were made. In response, the Examiner issued the final Office Action appealed herein. No amendments to the claims were filed subsequent to the final rejection.

5.   **SUMMARY OF THE CLAIMED SUBJECT MATTER**

Claim 1: An improved graphical user interface (GUI) having a GUI selection box capable of displaying a selection set of items when a selection button is manipulated in a first manner, the improvement comprising: a hot list box displaying a subset of items from said selection set of items when said selection button is manipulated in a second manner (Page 4, lines 13-19), wherein said subset of items displayed in said hotlist box is selectable by a user of said GUI (Page 5, lines 3-19).

Claim 9: A method of providing a computer graphical user interface, utilizing a screen interface and a pointing device controlling a pointer, to perform a plurality of related functions, comprising: selecting a selection box through the appropriate positioning and manipulation of the pointer by way of said pointing device, said selection box configured to display a selection set of items (Page 7, lines 1-5); selecting a hot list box through the appropriate positioning and manipulation of said pointer with respect to said selection box (Page 7, lines 6-8), said hot list box configured to display a subset of the items displayable in said selection set, wherein said subset of items

displayed in said hotlist box is selectable by a user of said GUI (Page 5, lines 3-19); and

selecting at least one of said items from said subset using said pointing device (Page 7,

lines 12-14).

Claim 11: A computer program product including a graphical user interface (GUI)

comprising: a computer-readable storage medium having computer readable program

code means embodied in said medium, said computer readable program code means

comprising: computer instruction means for displaying a selection set of items when a

selection button is manipulated in a first manner (Page 4, lines 13-19); and a hot list

box displaying a subset of items from said selection set of items when said selection

button is manipulated in a second manner (Page 4, lines 13-19), wherein said subset of

items displayed in said hotlist box is selectable by a user of said GUI (Page 5, lines 3-

19).

Claim 13: A data processing system comprising: a display area; a pointing

device; and a graphical user interface (GUI) further comprising: means for displaying a

selection set of items when a selection button is manipulated in a first manner (Page 4,

lines 13-19); and a hot list box displaying a subset of items from said selection set of

items when said selection button is manipulated in a second manner (Page 4, lines 13-

19), wherein said subset of items displayed in said hotlist box is selectable by a user of

said GUI (Page 5, lines 3-19).

The present invention is a customizable "hot list" used in connection with drop-down list boxes on web-based forms. The user can select, manually, which items are to be included in the customizable hot list. The customizable hot list appears on the user's screen when activated, e.g., when a drop-down list box is clicked with the right mouse button. This hot list presents a subset of the items contained within the drop-down list box, as selected by the user. The content of the hot list is determined manually, entirely by the user, via configuration of a "Preferences" menu option.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants request the Board to review the following rejections:

1. Rejection of Claims 1-3-5, 9, 10, 11 and 13 under 35 U.S.C. §102(e) as being anticipated by Ishisaki (U.S. Patent No. 6,938,216).

7. ARGUMENT

The Cited Prior Art Does Not Anticipate the Claimed Invention

The Examiner Has Not Established a *Prima Facie* Case of Anticipation

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The present claimed invention includes the feature of allowing a user access a "hot list" used in connection with a drop down list such as those commonly used on web pages. This hot list is a subset of items that are present in the complete listing of the drop down list. For example, if the drop down list is a listing of the United States, a user may define the hot list to be "New York, Pennsylvania, Virginia". Then by manipulating the selection button for the list in a second manner (e.g., right clicking as shown in Figure 5) only the hot list is displayed, making selection of one of the items contained on the hot list much quicker.

Specifically, Claim 1 recites:

> a hot list box displaying a subset of items from said selection set of items when said selection button is manipulated in a second manner, wherein the items to be included in said subset of items are manually selectable by a user of said GUI.

Each additional independent claim (9, 11, and 13) includes a variation of this limitation. This limitation is beneficial in the fact that it allows users to create custom menus that contain the items that will be of interest to them and quickly access these menus by manipulating a common selection button in a second manner. This subset, or hot list feature, defines the present claimed invention as novel over the prior art, including Ishisaki.

Ishisaki generally focuses on how pop-up menus are arranged and triggered to appear. In a portion repeatedly cited by the Examiner (col. 5, lines 3-34), Ishisaki only discusses the triggering of the menus, detailing how the number of successive clicks of a mouse button, or how the duration of a click of a mouse button is used as a determination

factor in deciding which pop-up menu is generated. Ishisaki, however, fails to teach or

suggest a user having the ability to determine which selectable items are included in a

subset of a listing of items being display as is claimed by the present invention. The user is

only given the option to add/delete and re-order the items in the menu, not manually create

a hot list menu that represents a subset of the selectable items on the menu. Col. 9, lines

57-65 of Ishisaki state:

> "The interface **1540** (FIG. 12B) is used to re-order the items of a selected
> menu. In other words, interface **1540** enables the user to modify the
> sequence in which items in each menu are displayed. Window **1560** reflects
> the current (default) order of the menu items and window **1570** reflects the
> newly defined order. The user re-orders the items using arrows **1581, 1582,**
> and either saves the order by clicking on the set button **1591** or cancels
> using cancel button **1592.**"

Ishisaki allows the user to re-order the items presented in the menu, but not add a

selectable item to the pop-up menu. Additionally, Ishisaki does not allow the user to

manipulate a selection button in a second manner to produce a subset of selectable

choices from a larger set. In contrast, the present claimed invention specifically recites

displaying a selection of items when a selection button is manipulated in a first manner,

and then displaying the hot list when a selection button is manipulated in a second manner

wherein the hot list is a subset of items chosen from the selection of items previously

displayed.

Inasmuch as Ishisaki does not teach or suggest the feature of allowing a user to

manually add a selectable item to a menu, and since this feature is specifically claimed in

independent Claims 1, 9, 11 and 13, it is submitted that the rejections of Claims 1, 9, 11

and 13 under 35 U.S.C. §102 based upon Ishisaki is inappropriate. Accordingly, each of

the independent claims, and all claims depending therefrom, patentably define over

Ishisaki and are in condition for allowance.

8.   CONCLUSION

For the foregoing reasons applicants respectfully request this Board to overrule

the Examiner's rejections and allow Claims 1, 3-11, and 13.

Respectfully submitted,

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Date

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CLAIMS APPENDIX

CLAIMS INVOLVED IN THIS APPEAL:

1. (Previously presented) An improved graphical user interface (GUI) having a GUI selection box capable of displaying a selection set of items when a selection button is manipulated in a first manner, the improvement comprising:

a hot list box displaying a subset of items from said selection set of items when said selection button is manipulated in a second manner, wherein said subset of items displayed in said hotlist box is selectable by a user of said GUI.

2. (Canceled).

3. (Previously presented) An improved GUI as set forth in claim 1, wherein said subset of items displayed in said hot list is displayed in an order selectable by the user.

4. (Previously presented) An improved GUI as set forth in claim 1, wherein a quantity of items displayed in said hot list box is selectable by the user.

5. (Previously presented) An improved GUI as set forth in claim 1, wherein a method of determining which of said items from said selection set are to be displayed in said hot list is selectable by the user.

6. (Original) An improved GUI as set forth in claim 5, wherein said method of determining which of said items from said selection set are to be displayed in said hot list comprises listing the most recently selected items.

7. (Original) An improved GUI as set forth in claim 5, wherein said method of determining which of said items from said selection set are to be displayed in said hot list comprises listing the frequently selected items.

8. (Original) An improved GUI as set forth in claim5, wherein said method of determining which of said items from said selection set are to be displayed in said hot list is applied to said hot list only after a predetermined number of items are to be displayed in said hot list.

9. (Previously presented) A method of providing a computer graphical user interface, utilizing a screen interface and a pointing device controlling a pointer, to perform a plurality of related functions, comprising:

selecting a selection box through the appropriate positioning and manipulation of the pointer by way of said pointing device, said selection box configured to display a selection set of items;

selecting a hot list box through the appropriate positioning and manipulation of said pointer with respect to said selection box, said hot list box configured to display a

subset of the items displayable in said selection set, wherein said subset of items

displayed in said hotlist box is selectable by a user of said GUI; and

selecting at least one of said items from said subset using said pointing device.

10. (Previously presented) The method of claim 9, wherein said hot list box is

selected by right-clicking a button on said selection box using said pointing device.

11. (Previously presented) A computer program product including a graphical

user interface (GUI) comprising:

a computer-readable storage medium having computer readable program code

means embodied in said medium, said computer readable program code means

comprising:

computer instruction means for displaying a selection set of items when a

selection button is manipulated in a first manner; and

a hot list box displaying a subset of items from said selection set of items when

said selection button is manipulated in a second manner, wherein said subset of items

displayed in said hotlist box is selectable by a user of said GUI.

12. (Canceled).

13. (Previously presented). A data processing system comprising:

a display area;

a pointing device; and

a graphical user interface (GUI) further comprising:

means for displaying a selection set of items when a selection button is manipulated in a first manner; and

a hot list box displaying a subset of items from said selection set of items when said selection button is manipulated in a second manner, wherein said subset of items displayed in said hotlist box is selectable by a user of said GUI.

14. (Canceled).

EVIDENCE APPENDIX

No additional evidence is presented.

RELATED PROCEEDINGS APPENDIX

No related proceedings are presented.